

REMARKS**1. Status of the Claims and Claim Numbering**

In the Notice, the Examiner asserts that the status of claims as indicated in Applicant's previously reply of November 11, 2008 is incorrect. Specifically, the Examiner alleges that the status of claims 40-42 is incorrect because only claims 1-39 were present in the amendment filed on April 21, 2008 (the "April 2008 Reply"). As explained below, in view of the history of claim amendments for this application, Applicant submits that the claim numbering in the April 2008 Reply amendments was erroneous. New claims 38 and 39 of the April 2008 Reply should have been numbered 41 and 42. The Office Action mailed on May 29, 2008, however, entered the amendments requested in the April 2008 Reply and thus sustained Applicant's erroneous numbering recognizing the presence of claims 1-39. Based on a correct accounting for claim numbering, Applicant submits that claims 21, 23, 35, 36, 41, and 42 are pending in this application. Claims 21, 23, 35, and 41 are allowed.

Shown below is an account of the pending and canceled claims during the prosecution history of this application. Only claim amendments that were entered are indicated.

Date	Pending Claims	Canceled Claims
08/28/03 (original claims)	1-20	None
09/13/06	21	1-20
09/21/06	21-40	1-20
05/09/07	21, 23-25, 27, 28, 35, 36	1-20, 22, 26, 29-34, 37-40
10/01/07	21, 23-25, 27, 28, 35, 36	1-20, 22, 26, 29-34, 37-40
04/21/08	21, 23, 35, 36, 38, 39	1-20, 22, 24-34, 37

As shown in the table, new claims 22-40 were introduced by Applicant's amendment of September 21, 2006. *See* Appendix A. These amendments were entered and then recognized in the Office Action mailed on November 9, 2006, which indicates pending claims 21-40. *See* Appendix B. Claims 37-40 were subsequently canceled in Applicant's amendment of May 9, 2007. *See* Appendix C. This amendment was entered and then recognized in the Office Action mailed on May 30, 2007, which indicates pending claims only up to claim 36. *See* Appendix D. The same claims, 21, 23-25, 27, 28, 35 and 36 were pending after Applicant's amendment of October 1, 2007, as indicated by the Office Action mailed on November 20, 2007. *See* Appendix E.

In view of this history, claims 1-40 have been present in the application since entry of the September 21, 2006 amendment, and Applicant's addition of new claims 38 and 39 in the April 2008

Reply was erroneous. *See* Appendix F. Claims 38 and 39 should have been numbered 41 and 42. To correct this erroneous numbering, as explained in Applicant's most recent November 11, 2008 reply, Applicant indicated claims 37-40 as being canceled, and new claims 38 and 39 from the April 2008 Reply as being number 41 and 42. Applicant submits that the claim status indications in April 2008 Reply showing claim 40 as canceled, 41 as previously presented, and 42 as currently amended, are accurate. In view of the foregoing, Applicant respectfully requests that the Examiner withdraw the Notice and review the April 2008 Reply as filed.

2. Conclusion

Applicant respectfully submits that the instant application is in good and proper order for allowance and early notification to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the instant application, the Examiner is encouraged to call the undersigned at the number listed below.

Respectfully submitted,

POLSONELLI SHALTON FLANIGAN SUELTHAUS PC

Dated: February 9, 2009

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APPENDIX A

Application No.: 10/604,943

Docket No.: 050992.0300.CPUS07

32. (new) The nucleic acid of claim 30, wherein the nucleic acid is capable of modulating expression of a target gene.

33. (new) The nucleic acid of claim 31, wherein the nucleic acid is at least 15/25 complementary to a binding site sequence of 18 to 24 nucleotides of a target gene and wherein the binding site sequence is located in an untranslated region of RNA encoded by the target gene.

34. (new) The nucleic acid of claim 32, wherein the nucleic acid is at least 15/25 complementary to a binding site sequence of 18 to 24 nucleotides of a target gene and wherein the binding site sequence is located in an untranslated region of RNA encoded by the target gene.

35. (new) A vector comprising an insert, wherein the insert consists of the nucleic acid of claim 21.

36. (new) A vector comprising an insert, wherein an insert consists of the nucleic acid of claim 25.

37. (new) A probe comprising insert, wherein an insert consists of the nucleic acid of claim 21.

38. (new) A probe comprising an insert, wherein an insert consists of the nucleic acid of claim 25.

39. (new) A gene expression inhibition system comprising the vector of claim 35 and a means for inserting said vector into a cell.

40. (new) A gene expression inhibition system comprising the vector of claim 36 and a means for inserting said vector into a cell.

APPENDIX B



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Director, COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-0450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,943	08/25/2003	Tobias Berndt	050992.0300.CPUS97	1942
17683	9/18/03	114092006		
ROSETTA-GENOMICS c/o PSWS 700 W. 47TH STREET SUITE 1000 KANSAS CITY, MO 64112			EXAMINER SHIN, DAIAH	
			ART UNIT 1633	PAPER NUMBER
			DATE MAILED: 11/09/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	104044-943	SENTRALICH, ITZ-HAX	
	Examiner	Art Unit	
Done Date	10/09		

-- THE MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

• Extension of time may be granted under the provisions of 37 CFR 1.13(b). In no event, however, may it exceed one year. If 37 CFR 1.3 is used, the mailing date of this communication is the earliest date of this correspondence.

• The period for reply is extended beyond the initial statutory period for reply set by this Office action if the reply is filed in reply to a communication that is not final. See 37 CFR 1.13(b). Any reply filed by the Office action date is deemed filed after the mailing date of this communication, even if it is filed prior to the end of the statutory period for reply.

Status

1) Response to communication(s) filed on 11 September 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1855 O.G. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 21-22 are pending in the application.
 4a) Of the above claim(s) are withdrawn from consideration.
 5) Claim(s) are allowed.
 6) Claim(s) 21-22 are rejected.
 7) Claim(s) are objected to.
 8) Claim(s) are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some c) None of:
 1) Certified copies of the priority documents have been received.
 2) Certified copies of the priority documents have been received in Application No. .
 3) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(b))
 * Give the attached detailed Office action for a list of the certified copies not received.

Attachments:

1) Notice of Allowance; Claim PTO-850
 2) Notice of Draftsmen's Drawing Revision; PTO-2401
 3) Information Disclosure Statement(s) (PTO/SB/46)
 Paper Deposited Date 10/06/06

4) Informative Summary (PTO-1410)
 Paper Deposited Date:
 5) Notice of Informal Patent Application
 6) OOA

APPENDIX C

Application No. 10/604,943

Docket No. 050992.0300.07USCP

AMENDMENTS TO THE CLAIMS

1. - 20 (Cancelled)

21. (Currently Amended) An isolated nucleic acid consisting of $18 \leq X \leq 20$ nucleotides wherein the sequence of the nucleic acid comprises:

- (a) at least $16 \leq Y \leq$ consecutive nucleotides of SEQ ID NO: 3769 NOS, 128, 131, or 133;
- (b) an RNA equivalent of (a);
- (c) a sequence at least 42/62 (7.2%) identical to (a) or (b); or
- (d) the complement of any one of (a)-(c),

wherein

 $X=18 \text{ to } 120$, $Y \geq 18$, and $X \geq Y$.

22. (Cancelled)

23. (Currently Amended) The nucleic acid of claim 21, wherein the at least $16 \leq X \leq$ nucleotides is ~~are~~ of a sequence selected from the group consisting of SEQ ID NOS: 477, 480, and 482.24. (Currently Amended) The nucleic acid of claim 21, wherein the nucleic acid consists of ≥ 18 to 24 nucleotides.25. (Currently Amended) The nucleic acid of claim 21, wherein $X=Y$, the sequence of the nucleic acid consists of:

- (a) SEQ ID NO: 3769;
- an RNA equivalent of (a);
- a sequence at least 42/63 nucleotides identical to (a) or (b); or
- the complement of any one of (a)-(b);

26. (Cancelled)

27. (Currently Amended) The nucleic acid of claim 2523, wherein $X=Y$, the at least 18 nucleotides is of a sequence selected from the group consisting of SEQ ID NOS: 477, 480, and 482.28. (Currently Amended) The nucleic acid of claim 25, wherein the nucleic acid consists of ≥ 18 to 24 nucleotides.

29. - 34 (Cancelled)

35. (Currently Amended) A vector comprising an insert, wherein the insert consists of the nucleic acid of claim 21.

36. (Currently Amended) A vector comprising an insert, wherein the insert consists of the nucleic acid of claim 25.

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Application No. 10/604,943

Docket No. 050992.0300.07USCP

37. - 40 (Cancelled)

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APPENDIX D



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Assistant Commissioner for Patents
 P.O. Box 1450
 Washington, D.C. 20546-1450
 (703) 305-1450

APPLICATION NO.	MAILING DATE	ENTRANCE NUMBER	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,943	08/12/2000	Initials: BZ	050992.0300.CPL507	1842
17588	1550	08/12/2000	EXAMINER	
ROSETTA-GENOMICS			SHIN, DANA H	
C/o PSWS			ART UNIT	PAPER NUMBER
700 W. 47TH STREET			1635	
SUITE 1000				
KANSAS CITY, MO 64112				
			MAIL DATE	DELIVERY MODE
			08/10/2000	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/604,943	BENTWICH, ITZHAK	
	Examiner Dana Shin	Art Unit 1835	
<i>— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —</i>			
Period for Reply			
<p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <p>- Extensions of time may be available under the provisions of 37 CFR 1.42(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</p> <p>If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</p> <p>Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</p> <p>Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any extended patent term adjustment. See 37 CFR 1.704(b).</p>			
Status			
<p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>09 May 2007</u>.</p> <p>2a) <input checked="" type="checkbox"/> This action is FINAL. 2b) <input type="checkbox"/> This action is non-final.</p> <p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 O.G. 11, 453 O.G. 213.</p>			
Disposition of Claims			
<p>4) <input checked="" type="checkbox"/> Claim(s) 21,23-25,27-29,33 and 35 is/are pending in the application.</p> <p>5a) Of the above claim(s) _____ is/are withdrawn from consideration.</p> <p>5) <input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6) <input checked="" type="checkbox"/> Claim(s) 21,23-25,27-29,33 and 36 is/are rejected.</p> <p>7) <input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.</p>			
Application Papers			
<p>9) <input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner.</p> <p>Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.89(a).</p> <p>Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).</p> <p>11) <input type="checkbox"/> The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.</p>			
Priority under 35 U.S.C. § 119			
<p>12) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (i).</p> <p>a) <input type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of:</p> <p>1. <input type="checkbox"/> Certified copies of the priority documents have been received.</p> <p>2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p> <p>3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p>			
<p>* See the attached detailed Office action for a list of the certified copies not received.</p>			
Attachments(s)			
<p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)</p> <p>Paper No(s) Mailed Date 2-2-07</p>		<p>4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) Mailed Date _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other. _____</p>	

APPENDIX E



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,943	06/28/2003	Izak Bearwich	USCP992.0300.07USCP	1942
3720	7590	11/20/2007	EXAMINER	
ROSETTA-GENOMICS	c/o PSWS		SHIN, DANA H	
700 W. 47TH STREET			ART UNIT	PAPER NUMBER
SUITE 1000			1635	
KANSAS CITY, MO 64112				
			MAIL DATE	DELIVERY MODE
			11/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/604,943	BENTWICH, ITZHAK
	Examiner Dana Shin	Art Unit 1635

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

• Examiner of Patent may be available under the provisions of 37 CFR 1.130(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

• If NO reply is filed by the specified date, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

• Failure to reply within the set or extended period for reply will, by statute, incur the application to become ABANDONED (35 U.S.C. § 133).

• Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any existing patent term adjustment. See 37 CFR 1.704(d).

Status

1) Responsive to communication(s) filed on 01 October 2007.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 21,23-25,27,28,35 and 36 is/are pending in the application.
 4a) Of the above claim(s) is/are withdrawn from consideration.
 5) Claim(s) is/are allowed.
 6) Claim(s) 21,23-25,27,28,35 and 36 is/are rejected.
 7) Claim(s) is/are objected to.
 8) Claim(s) are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some c) None of
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. .
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-848)
 3) Information Disclosure Statement(s) (PTO-1449/06)
 Paper No(s) Mail Date

4) Interview Summary (PTO-413)
 Paper No(s) Mail Date

5) Notice of Informal Patent Application
 6) Other:

APPENDIX F

AMENDMENTS TO THE CLAIMS

1. - 20. (Cancelled)

21. (Currently Amended) An isolated nucleic acid consisting of X nucleotides wherein the sequence of the nucleic acid comprises is selected from the group consisting of:

- (a) X consecutive nucleotides of SEQ ID NOS: 128, 131, or 133;
- (b) an RNA equivalent encoded by the nucleic acid of (a); and
- (c) a sequence at least 83.3% identical to (a) or (b); or
- (d)(c) the complement of any one of (a)-(e)-(a) or (b), wherein the complement is identical in length to (a) or (b),

X=204 to 420;

Y=29 to 320;

X=Y.

22. (Cancelled)

23. (Currently Amended) ~~The~~ An isolated nucleic acid of claim 21, wherein the X nucleotides are of a sequence of the nucleic acid is selected from the group consisting of: SEQ ID NOS: 477, 480, and 482

- (a) SEQ ID NO:477, SEQ ID NO:480, or SEQ ID NO:482;
- (b) an RNA encoded by the nucleic acid of (a); and
- (c) the complement of (a) or (b), wherein the complement is identical in length to (a) or (b).

24. - 34. (Cancelled)

35. (Previously presented) A vector comprising the nucleic acid of claim 21.

36. (Currently Amended) A vector comprising the nucleic acid of claim 25 23.

37. (Cancelled)

38. (New) A probe comprising the nucleic acid of claim 21.

39. (New) A probe comprising the nucleic acid of claim 25.